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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Seiichi Murakami**

Group Art Unit: **2629**

Serial No.: **10/568,416**

Examiner: **Dennis P. Joseph**

Filed: **February 14, 2006**

P.T.O. Confirmation No.: **7562**

Docket: **060118**

Date: **May 26, 2011**

For: **TRANSPARENT TOUCH PANEL AND
ELECTRONIC APPARATUS**

BRIEF ON APPEAL

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is filed herewith. This paper is in response to the Office Action mailed on February 28, 2011. This paper is a petition for an appropriate extension of time if needed. Please charge any fees needed for such an extension of time, and any other fees which may be needed to enter this paper, including \$540.00 the fee for an Appeal Brief (and Notice of Appeal), to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT & TRADEMARK OFFICE

Patent Application Serial No. 10/568,416

I. REAL PARTY IN INTEREST

The real party in interest is GUNZE LIMITED, 1, ZEZE, AONO-CHO,
AYABE-SHI, KYOTO 6238511, JAPAN

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II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

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III. STATUS OF CLAIMS

Claim 1 is pending, rejected, and appealed. Dependent claims 2-6 and 8-11 are pending, rejected, and not appealed. Claim 7 is canceled. (Claim 1 was objected to, but the objection is overcome by the Amendment of May 25, 2011, which should be entered as a matter of right.)

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IV. STATUS OF AMENDMENTS

The Amendment of May 25, 2011, which was submitted after the non-final Office Action February 28, 2011 and prior to the Notice of Appeal, should be entered as a matter of right. All other amendments have been entered.

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V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 recites,

*A transparent touch panel [Fig. 1] comprising:
a transparent first substrate [fixed substrate 130] and a second substrate
[movable substrate 110] each including a transparent electro-conductive layer [111,
131; page 5, line 19] on one surface thereof, the transparent first substrate and the
second substrate being arranged with a predetermined interval between each other
[Fig. 2 and Abstract] in such a manner that the transparent electro-conductive layers
are facing each other [Fig. 1], each transparent electro-conductive layer including a
respective pair of electrodes [112, 132; page 6, line 26] disposed on each end thereof
[Fig. 1];
a plurality of lead-out terminals [114, 134; page 6, line 30] being connected to
the electrodes through surrounding circuits [113, 133; page 6, line 29] extending to
the peripheral edges of the first substrate and the second substrate [Fig. 1, Abstract],
the lead-out terminals each being arranged on the opposing surfaces of the first
substrate and the second substrate [Fig. 1, Abstract]; and*

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a plurality of holding members [clips 80, 80 and 81, 81; page 7, line 16] that pinch a peripheral edge of only the transparent first substrate [Fig. 1] so as to sandwich [page 7, line 19] a periphery of the transparent first substrate, the holding members being formed of an electro-conductive material [page 7, line 18] and arranged so that each holding member includes a portion inserted between the transparent first substrate and the second substrate [page 7, lines 20-21] and in contact with at least one respective lead-out terminal of either the first or second substrate [page 7, lines 20-28].

The insertion of the holding members between the two substrates is best illustrated in Fig. 2, where the U-shaped member's upper bout is so inserted.

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claim 1 is rejected under 35 U.S.C. §103(a) as being obvious over Yukio, JP 2002-259054, in view of Mikio, JP 2001-092594.

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VII. ARGUMENT AGAINST REJECTION OF CLAIM 1

(under 35 U.S.C. § 103 over Yukio in view of Mikio)

(1) As to Yukio (which is equivalent to the Appellant's APA, see Appellant's Fig. 7 and Yukio's Fig. 2), the Examine admits that it does not disclose the subject matter of the last paragraph of claim 1, which is the paragraph which recites the holding members and their insertion. With regard to this feature, the Examiner states that Mikio discloses a connecting terminal 1 that pinches only the display substrate 2 (see Fig. 1 of Mikio) while being electrically connected to a signal lead-out terminal 3, which is attached to the periphery of the substrate 2. The Examiner asserts that it would have been obvious to one of ordinary skill in art to apply the connecting terminal 1 of Mikio to pinch only one of the two substrates 110 and 130 of Yukio.

(2) Mikio and its connecting terminal 1 are introduced into the rejection in response to the Appellant's assertions in earlier responses alleging that their holding members are configured to pinch only the first substrate (i.e., *one* substrate), in contrast to the references that pinch a *plurality* of substrates.

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However, the Appellant's holding members are not claimed to pinch only one substrate of a touch panel consisting of a *single* substrate, but rather are intended to pinch one of a *plurality* (two) of substrates composing a multilayer panel.

Moreover, the Appellant's holding members are further characterized in that a part of each holding member is *inserted* between the first substrate and the second substrate. With respect, it is believed that the Examiner has given insufficient weight to this feature.

(3) Unlike the Appellant, Mikio nowhere discloses a structure in which a portion of the holding member (connecting terminal) is inserted *between* first and second substrates composing a touch panel. The honorable Board is requested to consider Paragraph [0022] of Mikio in the form of a better translation supplied by the undersigned attorney's foreign associate:

"In the structure in which the display device of the present invention is applied to a resistive touch sensor, the touch sensor comprises a glass or plastic first electrode plate on which the position-detecting membrane and the parallel electrodes in contact therewith are formed; and a second electrode plate on which the position-detecting membrane and the parallel electrodes in contact therewith are formed; these sides of the first and second electrode plates having the membranes and the electrodes being opposed to each other with a predetermined interval; and a connecting terminal electrically connected to the parallel electrodes of the first electrode plate while holding the first electrode plate. *In the resistive touch sensor, two electrode plates are disposed so that the respective position-detecting membranes and the parallel electrodes are opposed to each other with a small gap; therefore, it is not possible to*

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insert a connecting terminal between the gap, i.e., it is not easy to configure the connecting terminal to pinch each electrode plate. This defect arises, however, only when the two electrode plates have the same size. By using a first electrode plate larger than the second electrode plate, it is possible to ensure a space for pinching the first electrode plate by the second electrode terminal. [Emphasis added.]

The Board is invited to note that, in the examples shown in Figs. 10 to 15 of Mikio, the lower electrode plates 312 and 412 are larger than the upper electrode plates 311 and 411. The connecting terminals 33 and 43 each pinch just one of the two electrodes—the lower electrode plate 312 or 412. However, the upper part of the connection terminal 33 or 43 is *not* inserted between the lower electrode plate 312 or 412 and the upper electrode plate 311 or 411, but is disposed on the portion of the lower electrode substrate 312 or 412 to which the upper electrode plate 311 or 411 does not extend. Further, the connecting terminal 33 or 43 pinches the lower electrode plate 312 or 412 together with the liquid crystal display device 32 or 42, rather than the upper electrode plate 311. Such a structure differs from those of the Appellant's holding members, that pinch only the first substrates.

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The Appellant submits that Mikio does not teach to insert any connecting terminal between the two electrode plates; and therefore, even if the connecting terminal of Mikio were combined with the structure of Yukio (not admitted obvious), the person of ordinary skill would not have obtain a structure in which a connecting terminal pinches just one of the two substrates 110 and 130, with one portion of the terminal inserted between the substrates 110 and 130.

The other figures of Mikio support this hypothesis: Fig. 3 shows two coextensive substrates 11 and 12 grasped by a single member 13, *without* any portion being inserted between. Figs. 5 and 13 are similar. The teaching of the reference is clear.

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CLAIMS APPENDIX

The following claims are according to the Amendment of May 25, 2011:

1. (previously presented): A transparent touch panel comprising;
a transparent first substrate and a second substrate each including a transparent electro-conductive layer on one surface thereof, the transparent first substrate and the second substrate being arranged with a predetermined interval between each other in such a manner that the transparent electro-conductive layers are facing each other, each transparent electro-conductive layer including a respective pair of electrodes disposed on each end thereof;
a plurality of lead-out terminals being connected to the electrodes through surrounding circuits extending to the peripheral edges of the first substrate and the second substrate, the lead-out terminals each being arranged on the opposing surfaces of the first substrate and the second substrate; and
a plurality of holding members that pinch a peripheral edge of only the transparent first substrate so as to sandwich a periphery of the transparent first substrate, the holding members being formed of an electro-conductive material and arranged so that each holding member includes a portion inserted between the transparent first substrate and the second substrate and in contact with at least one respective lead-out terminal of either the first or second substrate.

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2. (original): The transparent touch panel according to claim 1, wherein the thickness of the portions of the holding members inserted between the transparent first substrate and the second substrate is 0.5 to 2 times the space between the transparent first substrate and the second substrate.

3. (previously presented): The transparent touch panel according to claim 1, comprising notched portions formed in a portion of the second substrate which is in contact with the holding members.

4. (original): The transparent touch panel according to claim 1, wherein the transparent first substrate has a plurality of groove portions in the surface opposite to the surface on which the transparent electro-conductive layer is formed, and the holding members are held in groove portions.

5. (original): The transparent touch panel according to claim 1, wherein the transparent first substrate is a fixed substrate.

6. (previously presented): An electronic apparatus comprising the transparent touch panel of claim 1 and a display apparatus including electrically-conductive connecting terminals, the transparent touch panel being disposed on a display surface side of the display apparatus, and the holding members being in direct contact with the

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connecting terminals, whereby the apparatus and the lead-out terminals are electrically coupled.

7. (canceled)

8. (previously presented): The transparent touch panel according to claim 1, wherein the holding members are U-shaped and an interior of the U overlaps the at least one peripheral edge of the transparent first substrate.

9. (previously presented): The electronic apparatus according to claim 6, wherein the holding members are U-shaped, an interior of the U overlaps the at least one peripheral edge of the transparent first substrate, and the connecting terminals are in direct contact with a leg of the U-shape.

10. (previously presented): The transparent touch panel according to claim 1, wherein the peripheral edge of the transparent first substrate is sandwiched between an upper-side surface and a lower-side surface of each holding member.

11. (previously presented): The transparent touch panel according to claim 3, wherein a warp of the notched portions generates pressing force between the movable substrate and the holding members.

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EVIDENCE APPENDIX

There is no evidence to submit.

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RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571-273-8300) on May 26, 2011.

Nick Bromer (reg. no. 33,478)

Signature

Nick Bromer